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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,701

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Jeff Stewart

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EXAMINER

GARCIA, GABRIEL I

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

08/24/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary	Application No. 10/668,701	Applicant(s) STEWART ET AL.	
	Examiner GABRIEL I. GARCIA	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/7/09 & 7/27/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Part III DETAILED ACTION

1. Claims 24-47 are still provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-33 of copending Application No. 09/709,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the current application and copending are drawn to a method of previewing a document. (i.e. Claim 24 recited a generating a print file (reads on generating as recited in claim 12 of '433); transmitting and receiving the print file from the server (reads claim 12 recited on the obtaining the print file from the server as recited by '433) ; and displaying the image data in an interface at the client in response to the receiving (reads on the providing the preview for display at the client. Claim 12 of '433 teaches using a system software, not a print driver. However claim 13 of '433 teaches that the use of the system software as a print driver. Therefore, It would have been obvious to one of ordinary skill at the time to provide substitute the system software as the print driver as described in claim 13 of '433 in order to use a printer that can be use by different print drivers, therefore improving the versatility of the printer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 24-47 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for generating and transmitting print files and prompting the user without any further user interaction after the request to print. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The specification at no point discusses performing all of the steps of "automatically transmitting" and "without user initiated interaction with the server" as recited in claims 24 and 36. In fact, the specification actually discusses that a user would have to manually log in to the system between the steps of generation and transmission (page 23, lines 9-14 of applicant's specification).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 24-28,30-39 and 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (6,615,234) in view of Tonkin (6,314,568).

With regard to claim 24, Adamske et al teaches a method of previewing a document (e.g. abstract)) a document, comprising: generating a print file on a client based on the document using a print driver executing on a client in response to a print request for the document designating the print driver (e.g. fig. 8, and col. 7, lines 32-44); and displaying the image data in an interface at the client based on the transmitted print file (e.g. col. 2, lines 4-60). Adamske et al teaches automatically user uploading or transmitting and receiving the print file to the server without user initiated interaction with the server (col. 5, lines line 64- thru col. 7, line 15, clearly once the file is received thew configuration wizard can send it to the server, no user interaction is needed). Adamske et al fails to teach the displaying image data generated by the server and provided to the user based on the print file that was transmitted or uploaded. However, Adamske et al.discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske et al.). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

With regard to claims 25 and 26, Adamske et al fails to teach selecting a print driver and displaying a list of print drivers on the client; and choosing a desired print driver (e.g. figs. 5-8, and col. 7, lines 32-44). Adamske et al. discloses a method in

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which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske et al.). Adamske et al. does not the selecting of the print driver. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske et al. because it would have allowed the user to see the format type the print file would be in. With regard to claim 27, Adamske et al. further teaches obtaining step includes transmitting the print driver to the client over the network (reads on fig. 1-10) .

With regard to claim 28, Adamske et al further teaches creating the document using an application installed on the client (see abstract).

With regard to claim 30, Adamske et al. teaches verifying the print driver (application) the transmitting step (e.g. col. 3, lines 47-63).

With regard to claim 31, Adamske et al further teaches selecting file information associated with the print file using the interface (reads on fig. 3).

With regard to claim 32, the limitations of claim 32 are covered by the limitations of claim 24 above; and Adamske et al further teaches the upload manager (reads on fig. 9 for transmitting the print file (e.g. col. 5, lines line 64- thru col. 7, line 15).

With regard to claim 33, Adamske et al further teaches a version manager for verifying the print driver before transmitting the print file ((e.g. column 5, line 64-column 7, line 15).

With regard to claim 34, Adamske et al further teaches an application for creating the

document, wherein the application is installed on the client (reads on figs 1-3 and abstract)

With regard to claim 35, Adamske et al further teaches a wide area network, and the Internet (e.g. fig. 1-3).

With regard to computer program claims 36-39 and 41-42, the steps of the computer claims 36-39 and 41-42 read on the steps of the method claims 24,25,27-31 are describe above. The method steps of claims 24,25 and 27-31 can be program and store in the memory (208,209 or 232) of Adamske et al to create computer programs of claims 36-39 and 41-42.

With regard to claim 43, Adamske et al further teaches wherein the print file comprises a postscript file (see abstract).

With regard to claims 44-46, Adamske et al further teaches selecting a finishing option (e.g. binding) for the document, wherein the image data is further based on the selected finishing option (reads on fig. 3).

With regard to claim 47, the limitations of claim 47 are covered by the limitations of claim 43 above.

4. Claims 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (6,615,234) as applied to claims 24 and/or 32 above, and in further view of Grohs et al. (2001/00433753).

With regard to claim 29, Vidyanand teaches the communication of data between the client and printer (see fig. 1), but fails to explicitly teach compressing the print file before transmitting step. However, Grohs et al. (in the same field of endeavor “data processing” teaches that it is well known in the art to compress the print file before transmitting it [0032]. Therefore, it would have been obvious to one of ordinary skill in the art to provide the system of Vidyanand with the ability of compressing the data as taught by Grohs et al. because of the following reasons; 1) as suggested by Grohs et al. in paragraph [0032]. To reduce time and resources, and 2) to allow the system of Cooper et al. to send the data a lot faster by compressing large files before transmitting them.

With regard to computer program claim 40, the steps of the computer claim 40 read on the steps of the method claim 29 above. The method steps of claims 40 can be program and store in the memory (208,209 or 232) of Adamske et al to create computer programs of claims 40.

Conclusion

4. Applicant's arguments with respect to claims 24-47 have been considered but they are not find to be persuasive. Applicant's argument that the prior art of record does not teach “automatically transmitting” and “without user intervention” has been addressed above.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in This Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

/Gabriel I Garcia/

Primary Examiner, Art Unit 2625

Gabriel I. Garcia
Primary Examiner
August 16, 2009